REMARKS

Claims 1 and 3-45 are currently pending in the application. By this amendment, claims 1, 26-32, and 39 are amended, claim 2 is canceled, and claims 40-45 are added for the Examiner's consideration. The above amendments do not add new matter to the application and are fully supported by the specification. For example, support for the amendments is provided at pages 13-15 and 18-19 of the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §101 Rejection

Claims 26-38 were rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. While Applicant disagrees with this assertion, to advance prosecution, Applicant has amended independent claims 26 and 32 in accordance with the Examiner's recommendations. Applicant submits that claims 26 and 32, as amended, are directed to statutory subject matter and respectfully requests the rejection of independent claims 26 and 32 be withdrawn.

Moreover, as claims 27-31 and 33-38 are dependent claims, depending from respective independent claims 26 and 32, Applicant submits that claims 27-31 and 33-38 are directed to statutory subject matter. Accordingly, Applicant respectfully requests that the rejection of dependent claims 27-31 and 33-38 be withdrawn.

35 U.S.C. §102 Rejection

Claims 1-7, 15, 18-20, 22, 26, 28, 32, 33, 35, and 39 were rejected under 35 U.S.C. §102(e) for being anticipated by U.S. Publication No. 2003/0061265 issued to Maso, *et al.* ("Maso"). This rejection is respectfully traversed.

In accordance with the guidelines set forth in MPEP 2131:

> A claim is anticipated only if each and every element as set forth in the
> claim is found, either expressly or inherently described, in a single prior art
> reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
> 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant submits that the reference applied by the Examiner does not show each and every feature of the claimed invention.

<u>Improper Rejection of Independent Claims 19 and 32</u>

Applicant notes that the Examiner did not address all of the features of independent claims 19 and 32, hence, the Examiner did not properly reject claims 19 and 32 as being anticipated by Maso under 35 U.S.C. § 102(e). Specifically, the Examiner has rejected claims 19 and 32 for having similar features as independent claim 1, however, the Examiner has failed to consider the specific features of independent claims 19 and 32, which include features that are clearly different than those features of independent claim 1. For example, claim 1 does not include the features of determining current conditions of a workload characteristic, evaluating the current conditions of the workload characteristics, or dynamically adjusting system administration criteria based on a threshold metric associated with the current conditions of the workload characteristics. As such, the Examiner has not covered all of the features of independent claims 19 and 32. Accordingly, since the Examiner has not covered all of the features of claims 19 and 32, Applicant submits that a clear issue was not developed between the Examiner and Applicant. Therefore, the next Office Action, which should clarify this issue, *cannot* be made final.

According to MPEP 706,

> Before final rejection is in order a clear issue should be developed
> between the examiner and applicant. To bring the prosecution to as
> speedy conclusion as possible and at the same time to deal justly by both
> the applicant and the public, the invention as disclosed and claimed
> should be thoroughly searched in the first action and the references fully

applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection.

Additionally, MPEP 706.07(a) notes:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

> Furthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Accordingly, Applicant respectfully submits that the Examiner may not make the next action final as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant."

Claims 1, 26, and 39

Claim 1 recites, in pertinent part:

> ... defining at least one criterion including a system level criterion, a transaction level criterion, a multi-transactional level criterion, and a workload characteristic...

Claim 26 recites, in pertinent part:

> ... a means for defining at least one criterion including a system level criterion, a transaction level criterion, a multi-transactional level criterion, and a workload characteristic of the transaction processing system...

Claim 39 recites, in pertinent part:

> ... a first computer code to define at least one criterion including a system level criterion, a transaction level criterion, a multi-transactional

level criterion, and a workload characteristic of the transaction processing
system…

Applicant submits that Maso does not define at least one criterion including a
system level criterion, a transaction level criterion, a multi-transactional level criterion,
and a workload characteristic. Rather, Maso discloses an application manager, which is
a constant monitoring and recovery system that enables the measurement of task
metrics and performance of software-based business applications. (Abstract.) The
application manager includes an instrumentation application program interface, which
includes an <u>instrument system performance</u> metrics feature. The instrument system
performance metrics feature monitors SNMP statistics, Windows NT/2000, and Perfmon
metrics. (Paragraph [0022].)

Accordingly, Maso discloses monitoring <u>system</u> performance metrics. However,
Maso does not disclose a system level criterion, a transaction level criterion, a multi-
transactional level criterion, <u>and</u> a workload characteristic. Accordingly, Applicant
respectfully requests the rejection of claims 1, 26, and 39 be withdrawn.

<u>Claims 19 and 32</u>

Claim 19 recites, in pertinent part:

> … determining current conditions of a workload characteristic;
> evaluating the current conditions of the workload characteristic; and
> dynamically adjusting system administration criteria based on a
> threshold metric associated with the current conditions of the workload
> characteristic.

Claim 32 recites, in pertinent part:

> … a means for determining current conditions of at least a workload
> characteristic;
> a means for evaluating the current conditions of at least the
> workload characteristic; and

a means for dynamically adjusting system administration criteria based on a threshold metric associated with the current conditions of at least the workload characteristic.

Despite the Examiner not addressing all of the features of claims 19 and 32, Applicant has attempted to address the rejection of claims 19 and 32 to advance prosecution. In doing so, Applicant submits that Maso does not dynamically adjust system administration criteria based on a threshold metric associated with the current conditions of the workload characteristic. Rather, Maso clearly explains:

> ... Administrators set parameters or metrics to create customized views that monitor the activity specific to their enterprise. Such metrics include load variations, average response time specific to a task occurring outside of the web page, and other enterprise specific issues. Specific risk and problem areas of any application can be easily identified and anticipated using P.A.M. *Administrators can also set metrics to respond only when a prescribed threshold is reached.* In this way, non-critical problems are addressed at low traffic times. (emphasis added) (Paragraph [0089].)

As is apparent from at least the above passage, Maso allows <u>administrators</u> to set thresholds to respond only when a prescribed threshold is reached. Thus, it is the administrator that takes an affirmative action when setting metrics, i.e., each time a threshold needs to be set, it is the administrator that sets the threshold. However, Maso does not <u>dynamically</u> adjust system administration criteria based on a threshold metric. As such, Applicant submits that Maso does not anticipate claims 19 and 32 and respectfully requests the rejection of claims 19 and 32 be withdrawn.

<u>Claims 2-7, 15, 18, 20, 22, 28, 33, and 35</u>

Claims 2-7, 15, 18, 20, 22, 28, 33, and 35 are dependent claims, depending on independent claims 1, 19, 26, and 32. For this reason, Applicant submits that these claims are thus distinguishable based on independent claims 1, 19, 26, and 32.

Accordingly, Applicant respectfully requests the rejection over claims 2-7, 15, 18, 20, 22, 28, 33, and 35 be withdrawn.

<u>Claim 3</u>

Claim 3 recites, in pertinent part:

> ... wherein the defining at least one trigger action step includes defining at least one of a system level trigger action and a transaction level trigger action.

Applicant submits that Maso does not define a transaction level trigger action. Rather, Maso discloses an application manager, which includes an instrument system performance metrics feature that monitors SNMP statistics, Windows NT/2000, and Perfmon metrics. (Paragraph [0022].) However, Maso does not disclose at least one <u>transaction</u> level trigger action. As such, Applicant respectfully requests the rejection of claim 3 be withdrawn.

35 U.S.C. §103 Rejection

Claims 8-14, 16, 17, 21, 23-25, 27, 29-31, 34, and 36-38 were rejected under 35 U.S.C. §103(a) for being unpatentable over Maso in view of U.S. Patent No. 6,738,933 issued to Fraenkel, *et al.* ("Fraenkel"). This rejection is respectfully traversed.

Claims 8-14, 16, 17, 21, 23-25, 27, 29-31, 34, and 36-37 are dependent claims, depending on independent claims 1, 19, 26, and 32. For this reason, Applicant submits that these claims are thus distinguishable based on independent claims 1, 19, 26, and 32. Accordingly, Applicant respectfully requests the rejection over claims 8-14, 16, 17, 21, 23-25, 27, 29-31, 34, and 36-37 be withdrawn.

<u>Claim 11</u>

Claim 11 recites, in pertinent part:

> ... associating the system level threshold metric with the at least one transaction identifier and with the at least one transaction level threshold metric.

Applicant respectfully disagrees with the Examiner's assertion that Fraenkel discloses associating the system level threshold metric with the at least one transaction identifier and with the at least one transaction level threshold metric. Instead, Fraenkel discloses a server agent that monitors server resource parameters, such as operating system resource parameters on a transactional server. The server agent also monitors various servers and network devices. (Col. 26, lines 3-9.) However, Fraenkel provides no disclosure as to associating a system level threshold metric with at least one transaction identifier and with the at least one transaction level threshold metric. Accordingly, Applicant respectfully requests the rejection of claim 11 be withdrawn.

Claim 16
Claim 16 recites, in pertinent part:

... acquiring a transaction list of currently executing transactions...

Applicant submits that Fraenkel does not acquire a transaction list of currently executing transactions. Rather, Fraenkel collects a large quantity of performance data during a monitoring session. Fraenkel automatically analyzes the collected data using a root cause analysis (RCA) application in order to locate performance degradations. (Col. 29, lines 2-20.) Fraenkel also allows the collected data to be provided to users in a list. However, while Fraenkel discloses collected data, there is no disclosure that the collected data is of currently executing transactions. As such, Applicant respectfully requests the rejection of claim 16 be withdrawn.

Other Matters
Addition of New Claims 40-45
Claims 40-45 are added for the Examiner's consideration. Applicant submits that claims 40-45 contain allowable subject matter. Moreover, no combination of the applied references teach or suggest the features of claims 40-45.

Improper Rejection of Claims

　　　Applicant submits that the Examiner did not properly reject claims as noted above. While stating that these claims were rejected, the Examiner never addressed the features of these claims as applied by the Examiner. For these reasons, Applicant submits that a clear issue was not developed between the Examiner and Applicant. As such, the next Office Action, which should clarify this issue, *cannot* be made final. (See MPEP 706 and 706.07(a), which are referenced above.)

　　　Accordingly, Applicant respectfully submit that the Examiner may not make the next action final, as in the previous Office Action a "clear issue [was not] developed between the examiner and applicant".

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CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 09-0457.

Respectfully submitted,

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